

## **REMARKS**

Applicants respectfully requests reconsideration of the above referenced patent application in view of the amendments and remarks set forth herein, and respectfully request that the Examiner withdraw all rejections. Claims 1, 9, 11, 12, 19, 21, 64, 65, 69 and 71 have been amended. No claims have been canceled. No claims have been added. Thus, claims 1-22 and 64-73 are pending.

### **35 U.S.C. §103(a) Rejections**

#### **35 U.S.C. §103(a) Rejection over *Hung***

The Office Action rejects claims 1, 3-5, 7, 12-22, 64, 65 and 68-73 under 35 U.S.C. §103(a) as being unpatentable over Hung, US Application No. 2003/0202356 (*Hung*). Specifically, *Hung* is alleged to disclose a device which illuminates a wheel from within the rotating reference frame of the wheel, as set forth in rejected claims 1, 3-5, 7, 12-22, 64, 65 and 68-73. Furthermore, the Office Action alleges that the inclusion of surface coatings, additional optical elements, and independently operated light sources with the claimed device would be obvious based on the apparatus described in *Hung*. To overcome a rejection under 35 U.S.C. §103(a), Applicants may show that there is at least one limitation of the claim which is not taught or suggested by any combination of the cited references, or alternatively add such a limitation by appropriate amendment, M.P.E.P. § 2142. For at least the following reasons Applicants traverse these rejections.

Currently amended independent claim 1 recites in a salient portion (emphasis added):

“...a means for positioning the light source within a rotating reference frame of a wheel, the positioning means to allow light from the light source **directed outside the wheel** such that an amount of light from the light source **incident upon and reflected from a visible surface** of the wheel is greater than an amount of light from the light source directed away from the visible surface of the wheel.”

Currently amended independent claim 64 recites in a salient portion (emphasis added):

“...a light source to provide light **outside a wheel**;  
  
a structural element in to which to mount the light source, the structural element to allow a portion of the provided **light to strike and be reflected from a visible surface...**”

Claims dependent from either of currently amended independent claims 1 and 64 have also been amended for consistency in claim language. Each of these amendments is supported in the original disclosure at least by FIGS. 2 through 6A and discussion thereof in paragraphs [0038] through [0053] of the specification. The supporting passages of the original disclosure describe, *inter alia*, a positioning means which allows light directed **outside** the wheel to **strike** and be **reflected** from a visible surface of the wheel.

*Hung* fails to disclose these limitations insofar as Figure 1 and paragraphs [0028]-[0030] describes a wheel 1 having holes 121 to allow light emitting elements 4 to transmit light **within** spokes 12 of wheel 1. In *Hung*, the light from light emitting elements 4 is directed **inside** spoke 12 of wheel 1 and passes through- i.e. is **refracted** from- the visible surface of wheel 1, rather than **striking** or being **incident upon** the visible surface of wheel 1.

Therefore, *Hung* fails to teach or suggest at least one limitation found in each of currently amended independent claims 1 and 64. In depending directly or indirectly from one of currently amended independent claims 1 and 64, each of dependent claims 3-5, 7, 12-22, 65 and 68-73 incorporate at least one limitation not taught or suggested in *Hung*. Accordingly, the claims are patentable and Applicants request that the rejection of claims 1, 3-5, 7, 12-22, 64, 65 and 68-73 under §103(a) based on *Hung* be withdrawn.

**35 U.S.C. §103(a) Rejection over *Hung* in view of *Lee***

The Office Action rejects claims 2 and 67 under 35 U.S.C. §103(a) as being unpatentable over *Hung* as discussed above regarding claims 1 and 64, and further in view of *Lee*, US Application No. 2003/0169595 A1 (*Lee*). Specifically, *Lee* is further alleged to teach a number of different types of light sources so as to anticipate the particular limitations of claims 2 and 67. For at least the following reasons Applicants traverse these rejections.

As discussed previously, *Hung* fails to disclose a positioning means which allows light directed **outside** the wheel to **strike** and be **reflected** from a visible surface of the

wheel, as set forth in currently amended independent claims 1 and 64. The Office Action does not offer *Lee* as further suggesting, nor does it teach or suggest, this limitation in any way. In depending directly or indirectly from one of independent claims 1 and 64, each of dependent claims 2 and 67 incorporate at least one limitation not taught or suggested by any combination of *Hung* and *Lee*. Accordingly, the claims are patentable and Applicants request that the rejection of claims 2 and 67 under §103(a) based on *Hung* and *Lee* be withdrawn.

**35 U.S.C. §103(a) Rejection over *Hung* in view of *Franklin***

The Office Action rejects claims 6 and 8 under 35 U.S.C. §103(a) as being unpatentable over *Hung* as discussed above regarding claims 1 and 7, and further in view of Franklin, USPN 2,526,548 (*Franklin*). Specifically, *Franklin* is further alleged to teach a lighting arrangement on a hubcap placed on a wheel, so as to anticipate the particular limitations of claims 6 and 8. For at least the following reasons Applicants traverse these rejections.

As discussed previously, *Hung* fails to disclose a positioning means which allows light directed **outside** the wheel to **be incident upon** and **reflected** from a **visible** surface of the wheel, as set forth in currently amended independent claim 1. The Office Action does not offer *Franklin* as further suggesting, nor does it teach or suggest, this limitation in any way. In depending directly or indirectly from independent claims 1, each of dependent claims 2 and 67 incorporate at least one limitation not taught or suggested by any combination of *Hung* and *Franklin*. Accordingly, the claims are patentable and

Applicants request that the rejection of claims 6 and 8 under §103(a) based on *Hung* and *Franklin* be withdrawn.

**35 U.S.C. §103(a) Rejection over *Hung* in view of *Hung2***

The Office Action rejects claims 9, 10 and 66 under 35 U.S.C. §103(a) as being unpatentable over *Hung* as discussed above regarding claims 1 and 64, and further in view of *Hung*, US Application No. 2002/0136020 (*Hung2*). Specifically, *Hung2* is alleged to describe a shading device 14 which anticipates the shield described in claims 9, 10 and 66. For at least the following reasons Applicants traverse these rejections.

As discussed previously, *Hung* fails to disclose a positioning means which allows light directed **outside** the wheel to **be incident upon** and **reflected** from a **visible** surface of the wheel, as set forth in currently amended independent claims 1 and 64. The Office Action does not offer *Hung2* as further suggesting, nor does it teach or suggest, this limitation in any way. In depending directly or indirectly from independent claims 1, each of dependent claims 9, 10 and 66 incorporate at least one limitation not taught or suggested by any combination of *Hung* and *Hung2*. Accordingly, the claims are patentable and Applicants request that the rejection of claims 9, 10 and 66 under §103(a) based on *Hung* and *Hung2* be withdrawn.

CONCLUSION

For at least the foregoing reasons, Applicants submit that the objections and rejections have been overcome. Therefore, claims 1-22 and 64-73 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application. Please charge any shortages and credit any overcharges to our Deposit Account No. 02-2666.

Respectfully submitted,  
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